



## REMARKS

Applicant's attorney wishes to thank the Examiner for the careful attention given this case. However, Applicant respectfully traverses the Restriction Requirement and requests reconsideration of this requirement in light of the remarks presented below. In order to be fully responsive, Applicant has elected with traverse the invention of Invention 25 (i.e., Claims 26-34).

The Examiner has inappropriately restricted the claims of the present application into a large number of distinct and independent inventions without consideration of a) the type of restriction being presented (i.e. restriction under 37 C.F.R. §1.142 as opposed to "restriction" as it relates to election of species under 37 C.F.R. §1.146); b) the *sua sponte* decision by the Commissioner to partially waive the requirement of 37 C.F.R. §1.141 *et seq*; (see MPEP §803.04) for nucleotide sequences; or c) the ability to search and consider the various inventions without serious burden. For all of these reasons, the restriction requirement should be withdrawn.

Although both a restriction under 37 C.F.R. §1.142 and an election of species under 37 C.F.R. §1.146 are considered "restrictions", the manner in which the application is handled when electing an invention as opposed to when electing a species are very different. Pursuing claims of an independent and distinct invention under 37 CFR §1.142 typically requires the filing of a "continuing" application, while an election of species allows the species to be examined in a single application if they are free of prior art. After an election of species, the Examiner is required to search the elected species, and if that particular species is allowable, the Examiner is then required to extend the search to the next species or member of the genus. This has a dramatic effect on the cost of acquiring and maintaining Applicant's patent portfolio. The Examiner fails to make this distinction, and therefore Applicant is unable to make a well-informed decision in even provisionally electing an invention. Accordingly, the restriction requirement should be withdrawn.

Secondly, even assuming *arguendo* that the Examiner is correct in his determination of the various independent and distinct inventions, the restriction requirement should be withdrawn for public policy reasons. MPEP §803.04 states that the Commissioner has partially waived the

requirements of 37 CFR §1.141 *et seq.* to permit a reasonable number of nucleotide sequences to be claimed in a single application (See *Examination of Patent Applications Containing Nucleotide Sequences*, 1192 O.G. 68 (November 19, 1996). Applicant is claiming a reasonable number (normally construed as less than 10) of sequences in the present application. Therefore the restriction requirement should be withdrawn as it violates the public policy statements of the USPTO.

Finally, Applicant respectfully submits that the Examiner will not be seriously burdened by searching and considering the inventions described in the restricted claims as they are all within the same art unit. MPEP §803, in relevant part, states that

“[I]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Therefore the restriction requirement should be withdrawn.

It is respectfully submitted that the Application is now in condition for examination allowance on the merits. Notice to such effect is respectfully requested.

Respectfully submitted,

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